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MHM No. 16274US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING

In the Application of:

Rebecca S. Busch

Serial No.: 09/713,619

Filed: 11/15/2000

For: A SYSTEM AND A METHOD FOR AN
AUDIT AND VIRTUAL CASE
MANAGEMENT OF A BUSINESS
AND/OR ITS COMPONENTS

Examiner: Carolyn Bleck

Group Art Unit: 3626

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Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450 on
April 28, 2005.

By: David Z. Petty

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RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner Bleck:

This paper responds to the Office Action in the above-entitled application, mailed April 7, 2005, and allowing 3 months for a response. This response is timely because it is being filed within the period set for response.

ELECTION

The Examiner stated that the Applicant is required under 35 U.S.C. 121 to elect one of Invention I (claims 1-3 and 13-16) and Invention II (claims 4-12 and 17-34). The Applicant provisionally elects Invention II (claims 4-12 and 17-34) *with traverse*. The Applicant requests

that the Examiner reconsider this restriction requirement and withdraw it for the reasons discussed below.

TRAVERSAL

The restriction requirement is respectfully traversed. First, the Applicant respectfully submits that a restriction requirement after an office action on the merits is improper. Second, the search and examination of the application has already been made.

I. The Restriction Requirement After An Office Action On The Merits Is Improper

Section 811 of the Manual of Patent Examining Procedures (MPEP) states the following (emphasis added):

37 CFR 1.142(a), second sentence states: “[I]f the distinctness and independence of the invention be clear, *such [restriction] requirement will be made before any action upon the merits*; however, it may be made at any time before final action in the case at the discretion of the examiner.” This means the examiner should make a proper requirement as *early as possible in the prosecution, in the first action if possible*, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a *serious burden* if restriction is not required.

As clearly stated in the MPEP, a restriction requirement should be made before a first action unless there will be a serious burden on the Examiner.

In this case, a first office action on the merits was mailed on September 23, 2004, but the Examiner did not make any restriction requirement. Furthermore, the Examiner had made a search with respect to the pending claims related to the allegedly distinct inventions of the present application. As clearly stated above, the present restriction requirement is improper because any

distinctness and independence of the allegedly different inventions of the pending claims would have been clear prior to the first office action. Also, since the Examiner has already performed a search, there is no serious burden on the Examiner as a result of not requiring restriction. Thus, the Applicant respectfully requests that the restriction requirement be withdrawn.

II. The Search Has Already Been Conducted And Has Not Subjected The Examiner To A Serious Burden

The restriction requirement is also respectfully traversed because “if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP Section 803. One of the “two criteria for a proper requirement for restriction between patentably distinct inventions” is that “[t]here must be a serious burden on the examiner if restriction is not required...” MPEP Section 803. While “[f]or purposes of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, or separate status in the art, or a different field of search... [t]hat *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.” MPEP Section 803.

The Applicant rebuts the Examiner’s *prima facie* showing because the Examiner has already made a search with respect to the pending claims related to the allegedly distinct inventions of the present application. Therefore, the Applicant respectfully traverses the present restriction requirement because the Examiner was not (and will not be) subjected to a serious burden because the search has been completed.

Furthermore, the Examiner was not (and will not be) subjected to a serious burden because

no serious burden is shown that justifies restriction. The two allegedly distinct inventions are both directed to the same task of auditing a business or process. Also, the two allegedly distinct inventions can be used together. Therefore, the Examiner was not (and will not be) subjected to a serious burden, and thus the restriction requirement should be withdrawn.

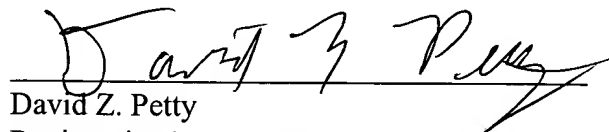
CONCLUSION

As discussed above, the Applicant respectfully submits that the present restriction requirement is improper and seemingly unnecessary. Therefore, the Applicant respectfully requests the Examiner to withdraw the restriction requirement.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Deposit Account 07-0845.

Respectfully submitted,

Dated: April 28, 2005



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